

REMARKS

This is a response to an Office Action dated February 24, 2011. All currently pending claims are rejected over a combination of references. Applicants have carefully reviewed the Office Action and respond to each of the grounds for rejection.

Claim Amendments

Claim 24 (which is duplicated by mistake in the claim index pages 1 & 3) is deleted.

Claim 25 is amended to recite “a news article”. Support for the amendment is in the Specification. See S. No. 09/634,725 at page 3, lines 4-8. This does not add any new matter. No other claim amendments are made. Examiner is respectfully requested to review and enter the amendment.

Interview with the Examiner

Applicants thank Examiner Lanier for the courtesies shown during telephone interviews on March 2, 2011, March 8, 2011, March 16, 2011 and March 21, 2011. The topic of the discussion was whether the C-i-P application is entitled to the filing date of the parent application for disclosure of an online repository for “information objects”. Initially, Applicants initially could not locate Provisional Application S. No. 60/178,028 (filed January 26, 2000), and believed that Meyer was filed on January 24, 2001. When informed of the provisional, Applicants asked the Examiner to send the same to Applicants for review. After a review of the disclosure in S. No. 60/178,028, Applicants discussed and expressed their view that Meyer (US2001/0031066) is still antedated by the parent application S. No. 09/478,796 (filed January 7, 2000). Applicants pointed to language from this application stating that “information comprises voice, video, data and/or text or any combinations thereof.” Examiner disagreed and stated that in his view “information” did not include what Examiner characterizes as “content.” The same issue arose in a related application, S.

No. 12/799,945. As will be shown below, Applicants never made any such distinction, and Applicants believe that this is a false distinction unsupported by the specification of 09/478,796. Because disagreements over terminology persisted, no individual claims were discussed.

Claim for priority to parent application

The Office Action suggests (as confirmed by the Examiner during telephone interviews) that the parent application was directed toward “information” whereas the instant application is directed toward “content”. As best as Applicants can understand this objection, Examiner appears to distinguish between “information” for which the Examiner refers to Table 1 of the disclosure (name, social security number, date of birth etc) from “content”, which is “a web page, a movie, a piece of music” etc. But this is a false distinction for which no support is in the specification. The parent application did not exclude “content” from “information.”

The following page and line references to the parent application, S. No. 09/478,796, show that the terms “information” and “content” were consistent. For example,

1. S. No. 09/478,796, at page 10, lines 24-25, states: "It should be noted that the type of information that can be stored in these tables can be unlimited."
2. S. No. 09/478,796, at page 8, lines 5-9, states:

In this application, any piece of information, however small in granularity or however agglomerated, is referred to as an "information object." Information objects can be implemented in an object-oriented manner, for example, each tuple or a field could be implemented as an object, a data structure or in any other manner known to persons skilled in the art.

3. S. No. 09/478,796, at page 20, lines 15-16 states: "information comprises voice, video, data, and/or text or any combinations thereof." No rule permits disregarding this clear statement in the disclosure.

4. S. No. 09/478,796, at page 9, lines 1-2, states: "information" is stored in " * * * multimedia methods of storage for other types of data"

5. S. No. 09/478,796, at page 18, lines 10-19 states:

In another embodiment, the user 103 requests the PIRSP to disburse information to the requester 103 using an electronic means (step 224). In this case, the user is authenticated and the information objects are downloaded or transmitted to the requester 105, preferably via secure E-mail, file transfer protocol, after establishing a circuit-switched connection, facsimile, U.S. mail or any other method. Preferably, the requester 105 is forbidden from reselling or retransmitting the information, or using it beyond an expiration date set either by the user 103 or by the PIRSP. Preferably, to ensure this, information objects are copyrighted or otherwise contractually protected. Further, this could be a selling point to users, since the PIRSP not only guarantees the safety of the stored information, but in addition controls how this information is used.

(Underlining added). Examiner is requested to note that "a web page, a link to a web page, a bookmark, a document, an e-book, an image, a piece of music, a piece of audio, a video clip, or a movie" (from claim 1) are examples of various types of "information", i.e., "voice, video, data and/or text or any combinations thereof." Further, Examiner is requested to note that "file transfer protocol" is generally used to transfer a "file," which is understood as "content," and "multimedia methods of storage" are used for what is understood as "content."

Finally, copyright is an attribute of works of authorship, namely, "content." See 17 U.S.C. § 102¹ (describing subject matter for copyright). A copyright gives the owner of copyright the right to control the use of the thing copyrighted. Copyrightable subject matter does not include name or date

¹ 17 U.S.C. § 102(a) provides: Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories: (1) literary works; (2) musical works, including any accompanying words; (3) dramatic works, including any accompanying music; (4) pantomimes and choreographic works; (5) pictorial, graphic, and sculptural works; (6) motion pictures and other audiovisual works; (7) sound recordings; and (8) architectural works. (Emphasis added).

of birth or social security number, (which are in Table 1) but includes a picture, a photograph or a poem, a song, a book, a movie, a speech, or a news article. By disclosing that information objects are “copyrighted or otherwise contractually protected,” therefore, Applicants inherently disclosed works of authorship as subject matter covered by the term “information object.” Note that for non-copyrightable subject matter covered by the term “information object,” Applicants suggested that a “contract” may be a way to protect information objects from unauthorized reuse, retransmittal or other control over the use of the information objects. See *Martin v. Johnson*, 454 F.2d 746, 751-52, 172 U.S.P.Q. 391, 395 (C.C.P.A. 1972)(“the description need not be in *ipsis verbis* to be sufficient * * * a skimpy disclosure can be augmented by showing the skill of the art to have been adequate to fill whatever voids there may be in the written specification.”)

Inherent disclosure is permitted under M.P.E.P. 2163.07(a). See also, *In re Smythe*, 480 F.2d 1376, 1384, 178 U.S.P.Q. 279, 285 (C.C.P.A. 1973) (disclosure by inherency); *In re Anderson*, 471 F.2d 1237, 1241 (C.C.P.A. 1973) (patent office may not restrict an invention to disclosed embodiments); *In re Eickmeyer*, 602 F.2d 974, 202 U.S.P.Q. 655 (C.C.P.A. 1979)(sufficiency of written description). See *Johnson Worldwide Assoc., Inc. v. Zebco Corp.*, 175 F.3d 985, 50 U.S.P.Q.2d 1607 (Fed.Cir.1999) (“the patent disclosure provides ample support for the breadth of the term ‘heading’; it does not ‘unambiguously limit[]’ the meaning of ‘heading’ to the direction of the motor.”) Giving an example of a thing does not operate as a restriction of the type of things and does not introduce a non-existent distinction between “information” and “content.” See *In re Dinh-Nguyen*, 492 F.2d 856, 859 (C.C.P.A. 1973). Discussing a related topic of disclosure by reference, the M.P.E.P. states:

Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. The information incorporated is as much a part of the application as filed as if the

text was repeated in the application, and should be treated as part of the text of the application as filed.

M.P.E.P. § 2163.07(b) (emphasis added). Even this suggests that the terms “information” and “content” are not to be understood in contradistinction to each other. Importantly, intrinsic evidence shows that Applicants did not distinguish or disclaim or otherwise differentiate “content” from “information,” and therefore it is not correct to create a false distinction or false dichotomy between “information” and “content.” The C-i-P application gave examples of “digital item” as “a news article, word processor document, spread sheet, presentation, e-book, software programs, music, video, movie, a graphical image such as a photograph, a three dimensional image, or a similar thing.” See S. No. 09/634,725 at page 3, lines 4-8. Thus, the term “digital item” is consistent with the term “information object”. Substituting “digital item” for “information object,” therefore, does not impact the claim for priority to the parent application for “content.” Examiner is respectfully requested to reconsider this point.

Rejection of claims pursuant to 35 U.S.C. § 102(e) and 35 U.S.C. §103(a)

The Office Action rejected Claims 32, 36-42 as being anticipated by Meyer under 35 U.S.C. § 102(e) and the remaining claims are rejected pursuant to 35 U.S.C. § 103(a) over a set of references of which Meyer (US2001/0031066) was the primary reference. For the reasons specified below these references either individually or in combination with each other or with other art of record do not render the claimed invention as a whole obvious to one skilled in the art at the time the invention was made. Specifically, as shown below, the cited references individually or in combination with other art of record do not motivate, suggest, or otherwise inform or enable a person of skill in the art to combine the references in the manner suggested by the Office Action to arrive at the claimed invention at the time the invention was made.

Meyer (US2001/0031066)

Notwithstanding the fact that priority to the instant application (based on the parent application S. No. 09/478,796) antedates Meyer, Meyer is not a pertinent reference to apply to the claims under examination. For one thing, Meyer is about steganographically stored information. Accordingly, it is believed that Meyer is not directed to an analogous art to the instant claims. Secondly, Meyer discusses something called "linked media objects". See Fig. 1 and discussion thereof. Meyer states that the disclosure is about "transform[ing] [media objects] "into active, connected objects via identifiers embedded into them or their containers." See ¶ [0007]. Meyer states that "'media object' and 'audio object' refer to an electronic form of a media signal and audio signal, respectively." See ¶ [0012]. Meyer states that "[w]hen the identifier is associated with metadata or actions, it transforms the media object into a "linked" object." See ¶ [0014].

The Office Action cites Meyer at ¶¶ [0030], [0057] & [0073] as applicable to the following step of claim 24:

a security module capable of making the one or more copyright-protected digital items accessible to the second party in accord with one or more constraints imposed by respective license information associated with the one or more copyright-protected digital items.

However, this is not so. The pertinent paragraphs from Meyer state as follows:

[0030] The server then returns a web page associated with the OID, or re-directs the OID to another server (e.g., one maintained by the content distributor or owner), which in turn, returns a web page of information about the object and links to related actions (e.g., a link to a licensing server, a link to a server for buying and downloading related music etc.). The licensing server may be programmed to download software players and new music offerings compatible with those players. For instance, the licensing server may provide software for decrypting, decoding, and playing electronically distributed music according to usage rules packaged with the electronically distributed music. In this application scenario, the linking of the MP3 file enables the content owner to market music and products that promote the sale of audio objects in other formats, included formats protected with encryption, watermark copy managements schemes, etc.

* * *

[0057] The embedding clearinghouse may also offer an identifier embedding services for those wanting to link their media objects with metadata, actions, etc. In this application scenario, the embedding clearinghouse may be implemented as an Internet server that is accessible via a web page using conventional network communication and web protocols. To access the server, users visit a web page using an Internet browser. In exchange for a fee, which may be tendered electronically over the Internet from the user's computer to the server, the server provides an embedding service to embed an identifier into a media object uploaded from the user via the user's computer and Internet connection. The user can select the information to associate with a media object, such as generic identifying information (e.g., title, author, owner), generic licensing information, or special information or actions. The provider of the embedding clearinghouse server hosts the generic information, while the special purpose information and actions are accessed through re-direction. In particular, the provider of the clearinghouse server links the embedded identifier to an address or set of addresses of servers that provide the special information or actions. Then at decoding time, the decoding process sends the identifier to the provider's server, which in turn, redirects the identifier to a secondary server or servers that provide special purpose information or actions (e.g., redirect to a web page of the content owner, download related content, provide electronic licensing services, etc.).

* * *

[0073] establishing a license to use a linked media object

Nothing in the cited paragraphs anticipates the above-stated element of claim 24. More importantly, it is submitted that the parent application, filed three weeks prior to Meyer, disclosed transmitting or downloading an information object in accord with use restrictions associated with copyright for the information object. See S. No. 09/478,796 at page 18, lines 15-19. Thus, Meyer is not a good reference for the security module. Examiner is respectfully requested to reconsider.

As to claims 36-37, the Office Action relies on Meyer at ¶ [0097] as a reference under 35 U.S.C. § 102(e) for a "browser." Applicants respectfully traverse this rejection because a browser is disclosed in the parent application. See S. No. 09/478,796 at page 6, lines 21-29.

As to claims 39-41, the Office Action additionally relies on Meyer at ¶ [0018] for the disclosure of a "formatter" in these claims. This rejection is respectfully traversed. The term

“format” as used in the instant application refers to something different from packaging. See, S. No. 09/634,725 at page 8, lines 1-30 (also, page 36 lines 26 through end of page 37), describing formatting the digital item to suit the requirements of the second computer:

For example, the requester's device may be capable of handling only a text-based interface, only a certain types of images such as only MPEG images, has a limited storage capability, or a limited viewing area. The requester's device may have other limitations on resources such as size and type of memory device; attached or attachable storage devices; input/output capability such as pointing device; voice recognition; text-to-speech capability; video input/output capability; numeric or alphanumeric keyboard; processing power; type of operating environment; whether or not a downloaded item can be locally executed; type of encryption/decryption; type of data communication or other protocol handled; file types; type and size of the viewing area or the like.

Clearly Meyer does not disclose this type of formatting a digital item to suit the requirements of the second computer. Reconsideration is respectfully requested.

As to claim 42, the Office Action reasons from the fact that Meyer suggested that the content could be video or images at ¶ [0012], it followed that Meyer also disclosed formatting a digital item to suit the requirements of a second computer. But such reasoning is not correct. At the cited paragraph, Meyer states:

[0012] The following sections describe systems and processes for linking audio and other media objects to metadata and actions via an identifier. For the sake of illustration, the disclosure focuses on a specific media type, namely audio signals (e.g., music, sound tracks of audio visual works, voice recordings, etc.). However, these systems, their components and processes apply to other types of media signals as well, including video, still images, graphical models, etc. As described further below, an identifier attached to an audio signal is used to connect that signal with metadata and/or programmatic or device actions. In the context of this document, the terms “media object” and “audio object” refer to an electronic form of a media signal and audio signal, respectively. The linking of media signals applies to objects that are transmitted over wire networks (such as a computer network), wireless networks (such as a wireless telephone network), and broadcast (AM, FM, digital broadcast, etc.).

It is respectfully submitted that nothing in this paragraph discloses formatting a digital item to

“fit the screen” of a second computer. Reconsideration of this rejection is respectfully requested.

For the foregoing reasons, Meyer is not a good reference because Meyer either individually or in combination with other art of record does not anticipate or render the claimed invention as a whole obvious to one skilled in the art at the time the invention was made. Examiner is respectfully requested to withdraw Meyer as a reference.

Erickson (USP 5,765,152 A)

The Office Action mentions Erickson in reference to Claim 26. See Office Action at page 5, ¶ 10 (stating that Erickson is a 35 U.S.C. § 102(b) reference to claim 26). It is respectfully submitted that Erickson does not anticipate or render obvious the instant claimed invention. Erickson describes a modified “DOCUMENT”, see Fig. 1 (label 12a), which “DOCUMENT” “means an electronic or digital file that is constructed according to the invention by packaging the electronic media into a secure document format to manage or otherwise enable the control, access, and/or licensing of the media.” Col. 3, lines 13-17. See also, Fig. 1A. Erickson does not disclose or anticipate or render obvious the following steps of instant claim 26:

- receiving a digital item;
- storing the digital item in a first user’s online library;
- if the digital item is copyright-protected, then
- receiving license information, said license information indicating that the license is for access of the digital item for a predetermined time (T_{license});
- permitting access the digital item in accordance with the time constraint imposed by the license information; and
- disabling access to the digital item upon expiration of the predetermined time (T_{license}).

Erickson does not have these features. Reconsideration is respectfully requested.

Atkinson (USP 6,367,012 B1)

Atkinson states that it is about “[incorporating a] certification or signature [] in a computer program, an executable file, or code to assure its authenticity and integrity, particularly for receiving

it over an open computer network like the Internet.” Thus, Atkinson² is not analogous art to the claims under review. Atkinson is dealt in further detail in the following remarks as applied to the claims for which Atkinson is used as a reference.

Glassman (USP 6,453,305 B1)

The Office Action combined Meyer with Glassman (USP 6,453,305 B1) to reject certain other claims. However, Glassman is directed toward a consumer accessing content using “license scrip” obtained from a vendor or broker. See Summary. This “Scrip,” as Glassman uses the word, “is primarily used as a form of electronic currency” or a “token representing a general value.” Applicants believe that this is not pertinent art to the instant claims.

As to claim 27, the Office Action relies on Meyer at ¶ [0099] in combination with Atkinson at Col. 9, lines 60-61. Paragraph [0099] in Meyer states:

[0099] For playback, a player application (e.g., device or application program on a computer) sends a request to a content delivery system via a wire or wireless connection. The content delivery system first checks to make sure that the user has the title in her on-line library. In addition, it may authenticate the user and determine usage rights before returning any content. If it determines playback to be authorized, the content delivery system sends the titles by streaming the content to the player application, on demand, in the order requested.

Atkinson at Col. 9, lines 60-61 states:

Publisher license expiration date 128 (FIG. 4) and agency license expiration date 196 (FIG. 8) provide respective digital certificates 122 and 190 with enhanced security by limiting the periods during which they are valid and therefore susceptible to attempted counterfeiting.

Claim 27 recites, in relevant part:

receiving a request from n requesters to access a copyright-protected digital item having N (where $N \geq 1$) licenses;

² Examiner is respectfully requested to note that Atkinson at Col. 1, lines 28-29 uses the word “information” as comprising “sound, images, video, etc.” and , at Col. 6, lines 4-5, states “information content * * * such as images, audio, video, executable programs, etc.”

allowing each of the n (where $n \leq N$) requesters to access the digital item for a predetermined period of time (T_{access}).

It is respectfully submitted that the Atkinson “Publisher license expiration date” or “agency license expiration date” are not relevant to instant Claim 27. Atkinson’s “Publisher license expiration date” or “agency license expiration date” are provided for “digital certificates 122 and 190” and thus are not for copyright-protected digital item in order to control the period of time a digital item may be accessed by a second user.

As to Claim 28, the Office Action relies on a combination of Meyer with Glassman at Col. 1, lines 55-62, and Col. 6, lines 12-19. Claim 28 depends from Claim 27 and recites, in relevant part:

establishing a waiting list for each of the remaining ($n > N$) requesters;
and
when one of the N licenses becomes available, permitting one of the requesters on the waiting list to access the digital item.

Neither Meyer nor Glassman individually or in combination with other references of record discloses associating license information with a digital item in an online repository, or determining the number N using license information or establishing a waiting list. Therefore, one of ordinary skill in the art would not have been able to combine Meyer with Glassman to arrive at the claimed invention at the time the invention was made.

Rejection of Claims 24-25, 29-31, 33-34 & 43 under 35 U.S.C. § 103(a)

The Office Action rejected 24-25, 29-31, 33-34 & 43 under 35 U.S.C. § 103(a) over Meyer in view of Glassman. The foregoing arguments regarding Meyer and Glassman are hereby incorporated by reference. Meyer and Glassman cannot be combined in the manner suggested by the Office Action to render obvious the instant claims.

As to Claim 24, neither Meyer nor Glassman individually or in combination discloses or suggests or renders obvious the steps of

storing the license information along with the copyright-protected digital item in the first user's online library;
examining the license information * * * to determine a number N * * * .

Reconsideration of this rejection is respectfully requested.

As to Claims 25 & 29, they are dependent on Claim 24 and are believed to be patentable for the reason Claim 24 is believed to be patentable.

As to Claims 30 & 31, Office Action appears to have misconstrued the term “format” as used in the instant specification. Arguments on this issue are presented above, see, pages 14-15 (discussing rejection of Claims 39-41). That discussion is hereby incorporated by reference.

As to Claims 33 & 34, the Office Action suggests that Glassman disclosed concurrent N-user license mechanism at Col 1, lines 55-62. See Office Action at page 9. At the same location, Glassman in fact appears to teach away from a “lock server” and states, “For these reasons, existing lock servers are undesirable on an open network.” Col. 2, lines 16-17. Glassman clarifies that one of ordinary skill in the art would not have combined Meyer to arrive at the invention claimed in Claims 33 & 34.

As to Claim 43, it recites:

receiving an identification of a digital item to be included in the first user's online library;
including the identified digital item in the first user's online library;
if the identified digital item is copyright-protected, then
determining a number N, (where $N \geq 1$) of times that the copyright-protected digital item may be simultaneously accessed; and
allowing the copyright-protected digital item to be simultaneously accessed no more than N times.

It is respectfully submitted that one of ordinary skill in the art would not have been able to combine these references in the manner suggested by the Office Action to render Claim 43 obvious at the time the invention was made.

Dependent Claims

Applicants argued the specific distinctions regarding certain dependent claims. As to the remaining dependent claims, they are believed to be patentable because independent claims from which they depend are believed to be patentable. Reconsideration is respectfully requested.

Conclusion

Those claims that are not specifically addressed are believed to be patentable for the same reasons give above. Applicants respectfully request reconsideration. No fee is believed to be due with this filing.

Respectfully Submitted,

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